

**REMARKS/ARGUMENTS**

In response to the Restriction Requirement mailed May 1, 2003, Applicants elect with traverse Group I, claims 1-3, drawn to a recombinant nucleic acid comprising a nucleic acid sequence that is selected from SEQ ID NOs:1, 3, or 5 and that encodes a MINK3 protein. Applicants traverse the restriction of group I and group II, drawn to recombinant MINK3 polypeptides.

Claim 1 is amended to recite hybridization is carried out in a solution containing 1.0M Na<sup>+</sup> ion, pH 7.0-8.3, at a temperature of 60°C, *i.e.*, stringent hybridization conditions. Support for this amendment is found in the specification, for example at page 19, lines 23-27. This amendment adds no new matter. Claims 1 and 2 are amended to recite that the nucleic acid sequence encodes a MINK3 protein. Support for these amendments is found throughout the specification, for example at page 4, lines 16-19. These amendments add no new matter. New claim 16 is added and is directed to nucleic acids that encode MINK3 proteins comprising an amino acid sequence of SEQ ID NOs:2, 4, or 6. Support for this amendment is found throughout the specification, for example at page 5, lines 19-21. This amendment adds no new matter. New claims 17-20 are directed to expression vectors that comprise the claimed nucleic acids, host cells that comprise the expression vectors and methods to make MINK3 proteins using the host cell. Support for these amendments is found throughout the specification, for example at page 6, line 28 through page 7, line 3. These amendments add no new matter.

The foregoing election is made with traverse. Applicants request that Group I, including claims 1-3 and directed to recombinant nucleic acids that encodes a MINK3 proteins; and Group II, directed to recombinant MINK3 polypeptides, *e.g.*, SEQ ID NOs:2, 4, or 6, be examined together, as the required MINK3 proteins in Group II are encoded by the recombinant nucleic acids of Group I.

Furthermore, restriction of an application is discretionary. A restriction requirement is made to avoid placing an undue examination burden on the Examiner and the Office. Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct

inventions. MPEP 803.01. Applicants respectfully submit that examining the claims of Groups I and II together (recombinant nucleic acids that encode MINK3 proteins and the encoded MINK3 proteins) would not place and undue burden on the Examiner.

In establishing that an “undue burden” would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show one of the following, as set forth in MPEP § 808.02:

(1) *Separate classification thereof:*

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(2) *A separate status in the art when they are classifiable together:*

Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(3) *A different field of search:*

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

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Amdt. dated June 30, 2003  
Reply to Office Action of May 1, 2003

PATENT

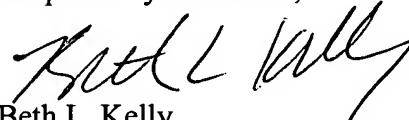
The present claims relate to a genus of MINK3 nucleic acids, which are claimed by common structural and functional features. The claimed genus of MINK3 nucleic acids encode MINK3 polypeptides. Applicants submit that searching Group II, corresponding to the encoded MINK3 polypeptides, places no undue examination burden on the Examiner. In particular, as sequence databases are now organized, search results for nucleic acid sequences routinely include any encoded amino acid sequences. Applicants therefore respectfully request that the restriction requirement with respect to Groups I and II be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
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